

IV. REMARKS:

The Assignee presents amendments to the claims above as well as remarks below in response to the Office Action of August 24, 2009. Claim 1 is currently amended and claims 1-14 and 27 are currently pending. Claims 15-22 and 24-25 have been withdrawn. Claim 1 and paragraph 56 of the specification have been amended to utilize the “built in” language suggested by the Examiner. This language is an acceptable way to describe features of the invention originally referenced in the paragraph and the related figures.

The action suggested concerns under 35 USC §102 proposing that the Buchanan reference (US 6,604,435 owned by the assignee of the present invention) may describe the “possibility of adjusting the injection point.” The applicant respectfully disagrees, Buchanan does not teach adjusting the injection point. In the section to which the action refers, it can be seen that the Buchanan reference merely mentions that cells can change orientation in the distance *before* they enter the Buchanan orienting nozzle assembly. As the Buchanan reference explains, this distance (i.e. from the injection point to its inventive nozzle orifice) is about 6mm. It makes no reference to adjusting this distance. Similarly, the Buchanan reference continues its explanation and details that the overall distance over which possible orientation changes can occur to the laser interrogation point (the key point for orientation) is about 10mm. {For clarity, in essence this shows that the distance from the nozzle orifice to the laser beam is 10mm-6mm or about 4mm.} Again, the Buchanan reference makes no reference to adjusting this overall 10mm distance. It does not disclose adjusting the injection point to greater than 10mm, does not disclose adjusting from 6mm to 10mm, and simply does not disclose any adjusting of the injection point as questioned in the action. The Buchanan reference works to orient the cells by its inventive nozzle design, but it does not teach any adjustable feature of the injection point as now invented.

With respect to the dependent claims, since independent claims 2-14 are ultimately dependent upon claim 1, it is believed that claims 2-14 are also novel over the art in that they each incorporate by reference all the limitation of the claims to which they are dependent. See

37 C.F.R. §1.75(c). Should the office require further explanation, the Assignee stands ready to supplement the above remarks if necessary.

The action also expressed concern under 35 USC §103 as to claims 7, 8 and “37.” The undersigned presumes the examiner meant claim 27 as there is no claim 37 and has taken the action in this light. Specifically, the action cited the above Buchanan reference (US 6,604,435) in further view of Newton (6,230,982). Under the statute, rejection is proper only if the invention was “obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” As the case of *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966) established, when assessing obviousness, the scope and content of the prior art are to be determined, the differences between the prior art and the claims at issue are to be ascertained, and the level of ordinary skill in the pertinent art is to be resolved. As further explained in *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007), it is important to understand if the problem in the field addressed by the patent can provide a reason for combining the elements of the references in the manner claimed. While the nature of the problem can vary and while uses can extend beyond a primary purpose, there should be a reason to consider applying the reference’s aspect to the invention’s problem to determine if a person of ordinary skill in the art has good reason to pursue the known option to lead to an anticipated success if the invention is to be held to represent merely ordinary skill and common sense. This is even set out in MPEP section 2141 *et seq.* which requires examiners to explain the relevant teachings of the prior art relied upon and to explain the differences in the claim over the applied reference.

The action relies upon a reference to Newton that discusses inserting a valve in a flowing stream such as for adding agrochemicals to farmlands. As the action itself states, this Newton invention is designed to avoid “unwanted chemical contamination of dispersing fluids” by “adjusting the position of the valve with respect to the center of the stream.” See Office Action at page 6. Importantly it must be assessed if a person of ordinary skill in the flow cytometry art would have understood this Newton agrochemical valve as representing a known option to lead to success in providing increased resolution of a flow cytometer measurement. As can be understood from the Newton figures alone, the Newton technology adjusts the valve laterally not “with respect to the central longitudinal axis” as now highlighted in Claim 1 of the present

invention. More to the point it would not yield the success of the present invention because it would not provide the type of longitudinal adjustment needed in this specialized application. Thus, it is respectfully explained that the differences between the subject matter as claimed in claims 7, 8, and 27, and the Newton reference are such that the subject matter as a whole would not have been obvious at the time the invention was made to a person of ordinary skill in the art.

Further, it should be noted that there is no comment whatsoever as to a reasoning relative to claim 8. Although the second paragraph on page 6 of the Office Action again references claim 7, it is not merely a typographical error intended to be claim 8 because it references the slide of claim 7 again, not the spiral threads of claim 8. An explanation as to claim 8 is requested if the position is maintained.

Finally, in the third paragraph on page 6, the Office Action indicates the discussion is concerning claim 37. The undersigned assumes that the examiner meant claim 27 as the patent application does not contain a claim 37. The undersigned respectfully explains that a slidably adjustable valve is not equivalent to a key stop. As shown from paragraph 57 of the published application, the slidable [engagement] and the keyed stop are two distinct means to achieve adjustment. Additionally, these differences can be clearly seen in figures 3B, 3C, and 3D with very different effects.

Additional Information

The amendments submitted herein or in any previous response should be understood to be made as a practicality only, and should not to be construed as creating any situation of file wrapper estoppel or the like as all rights are expressly reserved and may be pursued in this or other applications, such as divisionals, continuations, or continuations-in-part if desired. Relatedly, it should be understood that the amendments made herein are made for tangential issues of clarity and as a matter of the Office's convenience or expedience only. The amendments should not be interpreted as an action that in any way surrenders a particular equivalency, surrenders any right to patent coverage, or otherwise limits any rights which the Assignee may now or hereafter assert. It should be understood that, unless and to the extent

deemed broadened by this amendment, and even as amended, the Assignee expressly reserves all rights, including but not limited to: all rights to maintain the scope of literal coverage with respect to any element as may have existed under the language previously presented, all rights to maintain the scope of equivalency coverage as may have existed under the language previously presented, and all rights to re-present the prior language at any time in this or any subsequent application. To the extent currently foreseeable, no change or reduction in direct or equivalency coverage is believed to exist, and no change or reduction in direct or equivalency coverage is intended through the presentation of this amendment.

Further, the office and any third persons interested in potential scope of this or subsequent applications should understand that broader claims may be presented at a later date in this or a continuation in spite of any preliminary amendments, other amendments, claim language, or arguments presented, thus there is not intention to disclaim or surrender any potential subject matter. It should be understood that such broader claims may require that any relevant prior art that may have been considered may need to be re-visited since it is possible that to the extent any amendments, claim language, or arguments presented in this application are considered as made to avoid such prior art, such reasons may be eliminated by later presented claims or the like. Both the examiner and any person otherwise interested in existing or later coverage or considering the possibility of an indication of disclaimer or surrender of potential coverage, should be aware that no such surrender or disclaimer is intended or exists in this application. Limitations such as arose in *Hakim v. Cannon Avent Group, PLC*, 479 F.3d 1313 (Fed. Cir 2007), or the like are expressly not intended in this or any subsequent matter related.

CONCLUSION

The Assignee believes the pending claims to be in a condition for allowance and respectfully requests an allowance at the examiner's earliest convenience. Should any outstanding issues remain, the Examiner is invited to telephone the Assignee's representative, Luke Santangelo, at the phone number stated below.

Dated this 24th day of November, 2009.

Respectfully submitted,
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